

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Atty SCS-1498-125
Dkt.

1/Jan 2878



GARDNER

C# M#

Serial No. 09/806,007

TC/A.U. 2878

Examiner: Q. Le

Filed: March 26, 2001

Date: May 16, 2007

Title: IMPROVED PHOTOMULTIPLIER TUBE CIRCUIT

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

RESPONSE/AMENDMENT/LETTER

This is a response/amendment/letter in the above-identified application and includes an attachment which is hereby incorporated by reference and the signature below serves as the signature to the attachment in the absence of any other signature thereon.

 Correspondence Address Indication Form Attached.**Fees are attached as calculated below:**

| | | | |
|--|----|----------------------|--------------------------------|
| Total effective claims after amendment | 9 | minus highest number | |
| previously paid for | 20 | (at least 20) = | 0 x \$50.00 |
| | | | \$0.00 (1202)/\$0.00 (2202) \$ |

| | | | |
|------------------------------------|---|----------------------|--------------------------------|
| Independent claims after amendment | 3 | minus highest number | |
| previously paid for | 3 | (at least 3) = | 0 x \$200.00 |
| | | | \$0.00 (1201)/\$0.00 (2201) \$ |

If proper multiple dependent claims now added for first time, (ignore improper); add

\$360.00 (1203)/\$180.00 (2203) \$

Petition is hereby made to extend the current due date so as to cover the filing date of this paper and attachment(s)

| | |
|------------------------|--------------------------------------|
| One Month Extension | \$120.00 (1251)/\$60.00 (2251) |
| Two Month Extensions | \$450.00 (1252)/\$225.00 (2252) |
| Three Month Extensions | \$1020.00 (1253)/\$510.00 (2253) |
| Four Month Extensions | \$1590.00 (1254)/\$795.00 (2254) |
| Five Month Extensions | \$2160.00 (1255)/\$1080.00 (2255) \$ |

| | | |
|-----------------------------------|--|------------------------------------|
| Terminal disclaimer enclosed, add | | \$130.00 (1814)/ \$65.00 (2814) \$ |
|-----------------------------------|--|------------------------------------|

Applicant claims "small entity" status. Statement filed herewith

| | | | |
|---|--|--------------------|------|
| Rule 56 Information Disclosure Statement Filing Fee | | \$180.00 (1806) \$ | 0.00 |
|---|--|--------------------|------|

| | | | |
|--------------------------|--|-------------------|------|
| Assignment Recording Fee | | \$40.00 (8021) \$ | 0.00 |
|--------------------------|--|-------------------|------|

| | | | |
|--------|--|----|------|
| Other: | | \$ | 0.00 |
|--------|--|----|------|

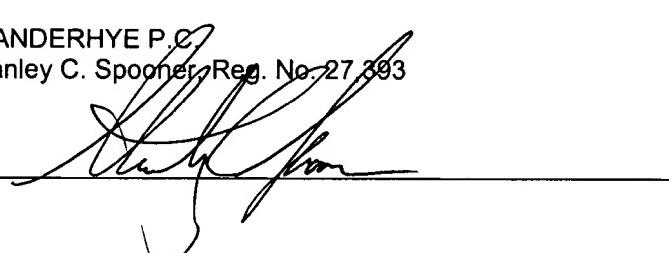
| | |
|------------------|----------------|
| TOTAL FEE | \$ 0.00 |
|------------------|----------------|

 CREDIT CARD PAYMENT FORM ATTACHED.

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140. A duplicate copy of this sheet is attached.

901 North Glebe Road, 11th Floor
Arlington, Virginia 22203-1808
Telephone: (703) 816-4000
Facsimile: (703) 816-4100
SCS:kmm

NIXON & VANDERHYE P.C.
By Atty: Stanley C. Spooner, Reg. No. 27,393

Signature: 



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

GARDNER

Atty. Ref.: 1498-125; Confirmation No. 1309

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* * * * *

May 16, 2007

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Sir:

RESPONSE TO RESTRICTION REQUIREMENT

This is responsive to the Restriction Requirement mailed April 17, 2007 (Paper No. 20070411), the date of response to which is May 17, 2007.

The Examiner's indication of PTO acceptance of the previously submitted formal drawings is very much appreciated. Additionally, the Examiner's acknowledgment of Applicant's claim for priority and receipt of the certified copy of the priority document is very much appreciated. However, Applicant notes that a signed and dated PTO Form 1449 is not included with this Official Action, even though Applicant submitted an Information Disclosure Statement on May 31, 2001. The Examiner's consideration of the prior art referenced in the originally filed Information Disclosure Statement would be very much appreciated.

Improper Restriction Requirement

Applicant notes that the Examiner has improperly attempted to require restriction under 35 USC §121. The present application is a national phase entry of PCT Application PCT/GB99/03090 and the Notice of Acceptance of such application was mailed by the PTO on December 1, 2004. The Manual of Patent Examining Procedure (MPEP) §1850 states that “PCT Rule 13.1 and 13.2 will be followed when considering unity of invention claims of different categories without regard to the practice in national applications filed under 35 USC 111.” Thus, the Examiner has erroneously applied the wrong standard, as restriction practice does not apply to national phase entries of a PCT application.

Instead of 35 USC §121, the test for PCT National Phase applications is “unity of invention” under PCT Rule 13.2 and, as mandated by the MPEP,

examiners should consider for unity of invention all the claims to different categories of invention in the application and permit retention in the same application for searching and/or preliminary examination, claims to the categories which meet the requirements of PCT Rule 13.2.

In view of the Manual of Patent Examining Procedure, the Examiner’s requirement to restrict to one of the two enumerated classes of inventions under 35 USC §121 is simply incorrect. As instructed by the MPEP, the Examiner is obligated to examine this national phase application with respect to the PCT rules, including the “unity of invention” test under PCT Rule 13.2.

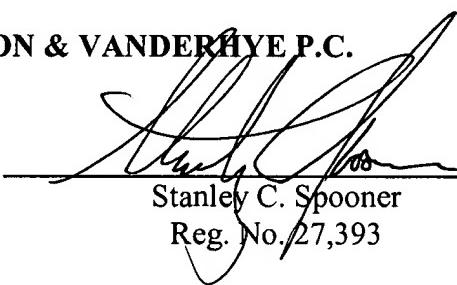
As required by the Examiner, Applicant elects Invention I with claims 1-7, with strong traverse, and the basis of the traverse is as noted above, i.e., the restriction requirement under 35 USC §121 is clearly erroneous in view of the above-noted MPEP requirements relating to PCT National Phase applications.

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Having responded to all objections and rejections set forth in the outstanding Official Action, it is submitted that claims 1-9 remain in this application. In the event the Examiner is of the opinion that a brief telephone or personal interview will facilitate allowance of one or more of these claims, he is respectfully requested to contact Applicant's undersigned representative.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: 

Stanley C. Spooner
Reg. No. 27,393

SCS:kmm
901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808
Telephone: (703) 816-4000
Facsimile: (703) 816-4100